

REMARKS

The above amendments and following remarks are submitted in response to the Official Action of the Examiner mailed May 5, 2003. Having addressed all objections and grounds of rejection, claims 1-20, being all the pending claims, are now deemed in condition for allowance. Reconsideration to that end is respectfully requested.

The Examiner has objected to the specification. The above specification amendments are deemed to fully address this objection.

The Examiner has objected to claims 1-2, 4-8, 10-11, 13, 15-16, and 18-19 under 35 U.S.C. 112, second paragraph as being indefinite. The claims have been amended above in a manner deemed fully responsive to this ground of rejection and the objections attendant thereto.

The Examiner has made a provisional rejection under the judicially created doctrine of obviousness type double patenting. As none of the involved claims are yet allowed, it is deemed advisable that action be postponed on behalf of Applicants. However, upon allowance of the claims over the other pending

objections and grounds of rejection, Applicants will take appropriate action with regard to a Terminal Disclaimer or other adequate response.

The Examiner has rejected claims 1-4, 6-9, 11-14, and 16-18 under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,924,094, issued to Sutter (hereinafter referred to as "Sutter"). This ground of rejection is respectfully traversed for the reasons provided below.

"It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention, and that such a determination is one of fact." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81, 90 (Fed. Cir. 1986). The rejection is respectfully traversed because Sutter does not meet every element of the invention claimed in claims 1-4, 6-9, 11-14, and 16-18 and because the Examiner has based her rejection upon clearly erroneous findings of fact.

Specifically, in rejecting claim 1, the Examiner states:

....a data wizard which permits said user to specify said service (See col. 6, lines 28-17, and col. 14, lines 39-45)....

The claimed element is a "data wizard". Sutter has no data wizard.

Claim 1 actually says that "said service" is utilized "for accessing a data base management system responsively coupled to said user terminal via a publicly accessible digital data communication network". A user of the Sutter system cannot make such "on-line" service requests because, as stated in the second and third sentences of the Abstract:

All application transactions are against the local database only, and every site stores "all and only" the data it needs. On-line transactions occur only in the background, including a periodical "synch" between sites that transmits any changes to data of interest to that site.

Therefore, the Examiner's finding is inconsistent with the reference and clearly erroneous on its face.

The Examiner continues by clearly erroneously stating:

....as an ordered sequence of discreet and independent steps (See Fig. 2c, 2d, where "steps" correspond to activities in "activity group"....

This finding is incorrect as a matter of law. The Examiner is not free to redefine the disclosure of the reference, simply to support her rejection.

An "activity group" according to Sutter is a group of sites, organized by the functions performed at those sites. It is a way for Sutter to specify which data is to be downloaded and updated (in the background) at each of the sites to permit all

transactions to be local. Sutter states at column 5, lines 25-28:

An activity group is defined as the group of sites presently collaborating on a given activity, i.e., storing a copy of that activity's data (or some sub-set thereof).

Thus, when Sutter says "activity group", it means a "group of sites" and specifically not "an ordered sequence of discreet and independent steps".

The Examiner continues by making the bizarre statement:

....and which present a plurality of valid steps as choices for addition at each position in said plurality of discreet and independent steps (See col. 37, lines 7-11).

For whatever reason, the Examiner has cited a portion of the description of Fig. 8¹. It seems as though the Examiner has attempted to find the individual words of Applicant's claimed invention without paying attention to the meaning of those words in the unique combination of the claim. Perhaps the Examiner was attracted by "....the next step in the organization of the application database...." of the citation. The Examiner has apparently ignored that these steps of the claimed invention must be used to form the "service" of the claimed invention.

As can be seen, the Examiner has based her rejection of claim 1 upon a number of clearly erroneous findings of fact and

¹Described at column 8, line 40, as a "block diagram" of a "database structure".

incorrect application of controlling law. Therefore, the rejection of claim 1, and all claims depending therefrom, is respectfully traversed.

In rejecting claim 3, the Examiner states:

Regarding claim 3, Sutter discloses said user terminal further comprises an industry compatible personal computer (See Fig. 1, and col. 9, lines 28-32).

This statement is both factually incorrect and legally insufficient. It is factually incorrect, because in neither citation (nor anywhere else in Sutter) are the "computers" defined. They may or may not be "industry compatible" and/or "personal computers". The statement is legally insufficient, because the Examiner apparently assumes something about the disclose of Sutter but which is not a part of the disclose of Sutter. She makes this assumption without authority.

Continuing her rejection of claim 3, the Examiner states:

Since Sutter system runs on the Internet (See col. 9, lines 43-45), having a commercially available browser is inherent because personal computer requires a browser in order to process data through Internet.

This statement is clearly erroneous factually, because a "personal computer does not require a browser in order to process data through Internet". There are numerous approaches to performing such data processing without utilizing a browser.

The statement is also procedurally incomplete, because the claim is limited by "a commercially available browser". Yet, the Examiner addresses only a "browser" without regard to whether it is or is not "commercially available".

Finally, the statement is incorrect as a matter of law.

MPEP 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

To the extent that the Examiner has provided any rationale, it is based upon a legally incorrect and clearly erroneous finding of fact as explained above. The rejection of claim 3, and any claim depending therefrom, is respectfully traversed.

In rejecting claim 4, the Examiner states:

Regarding claim 4, Sutter discloses said data wizard inhibits presentation of any step which would not be valid for the corresponding position within said ordered sequence (See col. 37, lines 14-19).

Sutter does not disclose a "data wizard" and the Examiner does not allege that it does. Furthermore, the citation deals with the organization of Sutter's data base. It has nothing to do with the definition of a "service". Finally, the citation has nothing to do with the claimed "inhibits presentation of any step". The rejection of claim 4, and any claim depending therefrom is respectfully traversed.

The rejection of claim 6 is based upon many of previously discussed clearly erroneous findings of fact and incorrect application of controlling law. For example, in finding claim element b, the Examiner disingenuously states:

b. a data base management system (See col. 6, lines 48-66) responsively coupled to said user terminal via a publically accessible digital data communication network (See col. 9, lines 40-47);

As the Examiner is no doubt aware, column 6, lines 48-66, describes the IDDBMS (i.e., Independent Distributed Data Base Management System) of Sutter. The IDDBMS is physically co-located at the user site and is specifically not coupled "via a publically accessible digital data communication network" as is limiting of the claim. The IDDBMS is located in the user's

computer. Sutter states at column 5, line 66, through column 6,
line 2:

The IDDBMS according to the present invention provides a mechanism whereby a site, working off-line from all others, can create a new record and therefore a new key.

It is deemed disingenuous that the Examiner would consistently disregard the clear teaching of Sutter to support her distorted and clearly erroneous findings of fact.

The Examiner continues:

c. a data wizard responsively coupled to said user terminal and said data base management system which permits a service to be defined from said user terminal (See col. 6, lines 28-37, and col. 14, lines 39-45) in accordance with an ordered sequence of discreet and independent steps (See Fig. 2c, 2d, where "steps" correspond to activities in "activity group", and col. 35, lines 4-14) and which presents a plurality of valid steps as choices for addition to said plurality of steps for each step of said plurality of steps (See col. 37, lines 7-11).

As explained in detail above, Sutter has no "data wizard".

Sutter's "activity groups" are groups of sites, not "sequences of discreet and independent steps". There is no opportunity for a user to adds "steps" to said "plurality of steps" which defines a "service".

The rejection of claim 6, and all claims depending therefrom, is respectfully traversed as based upon numerous clearly erroneous findings of fact and errors of law.

As explained above, the IDDBMS is located within the site computer and does not make service requests via any external link or network. Therefore, it cannot make service requests via the Internet. The rejection of claim 7, and any claim depending therefrom, is respectfully traversed.

The rejection of claim 8 is respectfully traversed because Sutton has no "data wizard", no "ordered sequence of steps", and therefore no "invalid steps" or means of presenting "valid steps".

The rejection of claim 9 is respectfully traversed for failure of the Examiner to make the required showings of MPEP 2112 to support her finding of inherency as discussed above in detail.

Claim 11 is limited to a method for building a service from a user terminal coupled via a publically accessible digital data network to a remote data base management system. It is deemed particularly ludicrous that the Examiner would seek to reject this claim utilizing Sutter, which describes a system wherein "all sites work off-line with local data"². It is not surprising that Sutter has none of the steps of Applicant's claimed

²See first sentence of Abstract.

invention, because Sutter has as his fundamental purpose the decentralization of that which Applicant seeks to centralize.

Applicant claims "presenting", "inserting", "presenting", "inserting", and "repeating" steps, all directed to the process of "building a service from a user terminal" for access "to a remote, centralized, data base management system". In making her rejection, the Examiner cites numerous portions of the description of Fig. 8. Column 8, line 41-42, states:

FIG. 8 shows in block diagram a database structure for an IDDB application.

In short, Applicant claims a novel method for building a service request to access a remote, centralized data base management system, whereas the Examiner citations describe Sutter's approach to structure a distributed database for local access. These are simply "apples" and "oranges". The rejection of claim 11, and all claims depending therefrom, is respectfully traversed as clearly not pertinent to the claimed invention.

The rejection of claim 12, and claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings of fact. Sutter has no "inhibiting", no "potential step", no "not valid for said next position", and no "ordered sequence of steps".

In rejecting claim 13, the Examiner states that Sutter mentions the Internet. However, the claim requires that the Internet be utilized to couple the user terminal with the remote data base management system. Sutter's data base management system is the IDDBMS which is co-located at the user's site. Therefore, the rejection of claim 13, and claims depending therefrom, is respectfully traversed.

Claim 14 is respectfully traversed as based upon clearly erroneous findings of fact as discussed above in detail.

Claim 16 is an apparatus claim containing "means-plus-function" limitations. Therefore, in addition to the numerous errors of law and clearly erroneous findings of fact explained above, the Examiner has failed to examine claim 16 in accordance with the requirements of MPEP 2181, et seq. Therefore, the rejection of claim 16, and all claims depending therefrom, is respectfully traversed for failure to utilized the required examination procedure in addition to basing her rejection upon clearly erroneous findings of fact and incorrect application of controlling law.

Claim 17 depends from claim 16 and further limits the "presenting means" by an "inhibiting means". Sutter has no "presenting means", so it is not a surprise that Sutter has no

"inhibiting means". The rejection of claim 17 is respectfully traversed as based upon clearly erroneous findings of fact.

Claim 18 depends from claim 17 and is further limited by the Internet coupling the "permitting means" and the "providing means". Sutter has no such structure. As stated in the Abstract, first sentence:

....all users at all sites work off-line with local data. The rejection of claim 18, and any claims depending therefrom, is respectfully traversed as based upon clearly erroneous findings of fact.

Claims 5, 10, 15, 19, and 20 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Sutter in view of Applicant's admitted prior art. This ground of rejection is respectfully traversed for the following reasons.

To make a *prima facie* case of obviousness under MPEP 2143, the Examiner must show 1) motivation; 2) reasonable likelihood of success; and 3) all claimed elements. The Examiner has made none of these showings.

As explained in great detail above, not all of the claimed elements are shown in the alleged combination. As to motivation and reasonable likelihood of success, the Examiner makes one summary statement:

The resultant use of the MAPPER data base management system would have performed the intended (by Sutter) function, without undue experimentation and with expected and obvious result (See applicant's specification, page 4, lines 7-12).

This statement is both inconsistent with controlling law and is clearly erroneous factually. It does not comply with the procedural requirements because it simply presents a conclusion. It does not in any way address the issues.

For example, Sutter's purpose is to create an Independent Distributed Data Base (see title). MAPPER by its nature is centralized. It cannot be distributed. Thus, Sutter and MAPPER are mutually exclusive. The alleged combination is inadequate as a matter of law.

Secondly, the MAPPER system "runs on proprietary hardware (see specification at page 4, line 13). Sutter makes no mention of the required proprietary hardware. With MAPPER, "the user must interface with the data base using a terminal coupled directly to the proprietary system" (see specification at page 5, lines 4-5). This is the antithesis of the IDDBMS approach of Sutter. Also the user "must access and manipulate the data using the MAPPER command language" (see specification at page 5, lines 5-6).

Thus, it is readily apparent that the alleged combination would not perform Sutter's intended function nor be implemented without undue experimentation. Therefore, the rejection of claims 5, 10, 15, and 19-20 is respectfully traversed for failure of the Examiner to present a *prima facie* case of obviousness as defined by MPEP 2143.

The rejection of claim 20 is respectfully traversed for the corresponding reasons presented above.

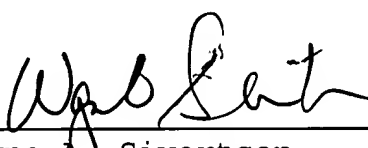
Having thus responded to each objection and ground of rejection, Applicants respectfully request entry of this amendment and allowance of claims 1-20, being the only pending claims.

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By his attorney,

Date August 5, 2003


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